



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,489	12/14/2000	Ryohei Sato	SON-0494US	8372

30743 7590 06/03/2005

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
----------	--------------

2686

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,489

Applicant(s)

Sato

Examiner

Rafael Perez-Gutierrez

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 19, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,12-14,18,22,23,29-31,35,39,40 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,12-14,18,22,23,29-31,35,39,40 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2686

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on November 19, 2004.
Claims 1, 5, 6, 12-14, 18, 22, 23, 29-31, 35, 39, 40, and 46-48 are now pending in the present application. **This Action is made FINAL.**

Drawings

2. The proposed drawing corrections filed on November 19, 2004 have been approved by the Examiner.
3. The replacement drawing sheet filed on November 19, 2004 has been accepted by the Examiner.

Claim Objections

4. **Claims 1, 18, 22, 23, 35, 47, and 48** are objected to because of the following informalities:
 - a) On **line 2** of **claims 1 and 35**, replace "and" with --an-- after "side";
 - b) On **line 12** of **claims 18 and 35**, replace "portable" with --self-portable-- after "which said";
 - c) On **line 2** of **claims 22 and 23**, insert --side-- after "termination"; and

Art Unit: 2686

d) On **line 2 of claims 47 and 48**, replace “portable” with --self-portable-- after “the”.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for a patent.

Claims 1, 5, 6, 18, 22, 23, 35, 39, and 40 are rejected under 35 U.S.C. 102(a) as being anticipated by **Fujii (JP 11-196469)**.

Consider **claims 1, 5, 18, 22, 35, and 39**, Fujii clearly shows and discloses a communication refusal (termination rejection) method, a Personal Handyphone System (PHS) telephone 1110a-1110c (figures 1 and 2) and a radio communication system for performing communication between a Personal Handyphone System (PHS) telephone 1110a-1110c (portable cellular phone set) (figure 1) on an origination side and a PHS telephone 1110a-1110c (portable cellular phone set) on a destination (termination) side through a base transceiver station apparatus 1111a-1111c (figure 1 and paragraphs 0014-0017), comprising:

first notifying, by means of a first notifying function provided on said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side, said PHS telephone 1110a-1110c (portable cellular phone set) on the origination side of a communication refusal (termination rejection) reason with respect to a communication (termination) request

Art Unit: 2686

from said PHS telephone 1110a-1110c (portable cellular phone set) on the origination side in a service (i.e., type of communication) with which said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side cannot cope (paragraphs 0008-0013, 0021, 0029-0034, and 0041),

second notifying, by means of a second notifying function (e.g., by displaying on a display) provided on said PHS telephone 1110a-1110c (portable cellular phone set) on the origination side, the communication refusal (termination rejection) reason from destination (termination) side outside (paragraphs 0011-0013, 0030-0034, and 0039),

switching, by means of a switching function provided on said PHS telephone 1110a-1110c (portable cellular phone set) on the origination side, to a service (i.e., type of communication, for example, voice (speech) communication) (paragraph 0040) with which said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side can cope on the basis of the communication refusal (termination rejection) reason from said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side (paragraph 0033 and 0039-0041),

wherein said switching function is allowed to switch to a service (i.e., type of communication, for example, voice (speech) communication) (paragraph 0040) with which said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side can cope on the basis of the presence/absence of information indicating a service type (e.g., voice (speech)) for the communication refusal (termination rejection) reason (i.e., by the addition/not addition of data classification and an advice of a condition of terminal inequality in the

Art Unit: 2686

communication refusal (termination rejection) reason (reads on **claims 5, 22, and 39**))
(paragraph 0033 and 0039-0041).

Consider **claims 6, 23, and 40**, and as applied to **claims 1, 18, and 35** above, Fujii also discloses wherein the function of switching to a service (i.e., type of communication, for example, voice (speech) communication) with which said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side can cope is allowed to switch to voice (speech) communication if information indicating the service type is not added to the communication refusal (termination rejection) reason (paragraphs 0032, 0033, and 0040).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2686

7. **Claims 12-14, 29-31, and 46-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fujii (JP 11-196469)** in view of **Nakajima (JP 07-231474)**.

Consider **claims 12-14, 29-31, and 46-48**, and as applied to **claims 1, 18, and 35** above, Fujii clearly discloses the claimed invention except wherein said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side includes a function of storing image data terminated at least during communication by a communication (termination) request which cannot be handled because an image display adapter for providing a service different from voice (speech) communication is not connected to at least said PHS telephone 1110a-1110c (portable cellular phone set) on the destination (termination) side, wherein the image display adapter is integrated or detachably connected to said PHS telephone 1110a-1110c (portable cellular phone set).

In the same field of endeavor, Nakajima clearly shows and discloses radio communication system, a method, and a cellular telephone 1 on a receiving (termination) side (abstract and figure 1) that includes a function of storing image data received at least during communication by a communication (termination) request which cannot be handled because an image display adapter (e.g., personal computer 18 or digital camera 20) (figures 4 and 5) for providing a service different from voice (speech) communication is not connected to at least said cellular telephone 1 on the receiving (termination) side, wherein the image display adapter is integrated (e.g., digital camera 20) or detachably connected to said cellular telephone 1 (abstract, figures 1, 4, and 5, and paragraphs 0005-0008 and 0016-0019).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

Art Unit: 2686

the invention was made to incorporate the storing function taught by Nakajima into the telephone taught by Fujii for the purpose of receiving image data even when an image display device is not available (Nakajima; abstract and paragraphs 0004-0006).

Response to Arguments

8. Applicant's arguments, filed on November 19, 2004, with respect to **claims 1, 5, 6, 18, 22, 23, 35, 39, and 40**, on page 11 of the remarks, have been considered but are moot in view of the new ground(s) of rejection necessitated by the new limitations added to **claims 1, 18, and 35**. See the above rejection of claims 1, 18, and 35 for the relevant citations found in Fujii disclosing the newly added limitations (specifically paragraphs 0039-0042 where Fujii discloses the use of data classification and the advice of a condition as part of the refusal reason for purposes of switching to a different service type).

9. Applicant's arguments, filed on November 19, 2004, with respect to **claims 12-14, 29-31, and 46-48** have been fully considered but they are not persuasive.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

Art Unit: 2686

Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: 2686

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

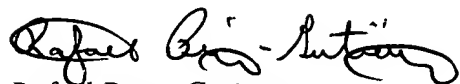
12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Art Unit: 2686

A handwritten signature in black ink, appearing to read 'Rafael Perez-Gutierrez', with a stylized, cursive script.

Rafael Perez-Gutierrez

R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**
PATENT EXAMINER

May 27, 2005

Refused by Sitre



6/20

FIG.7A

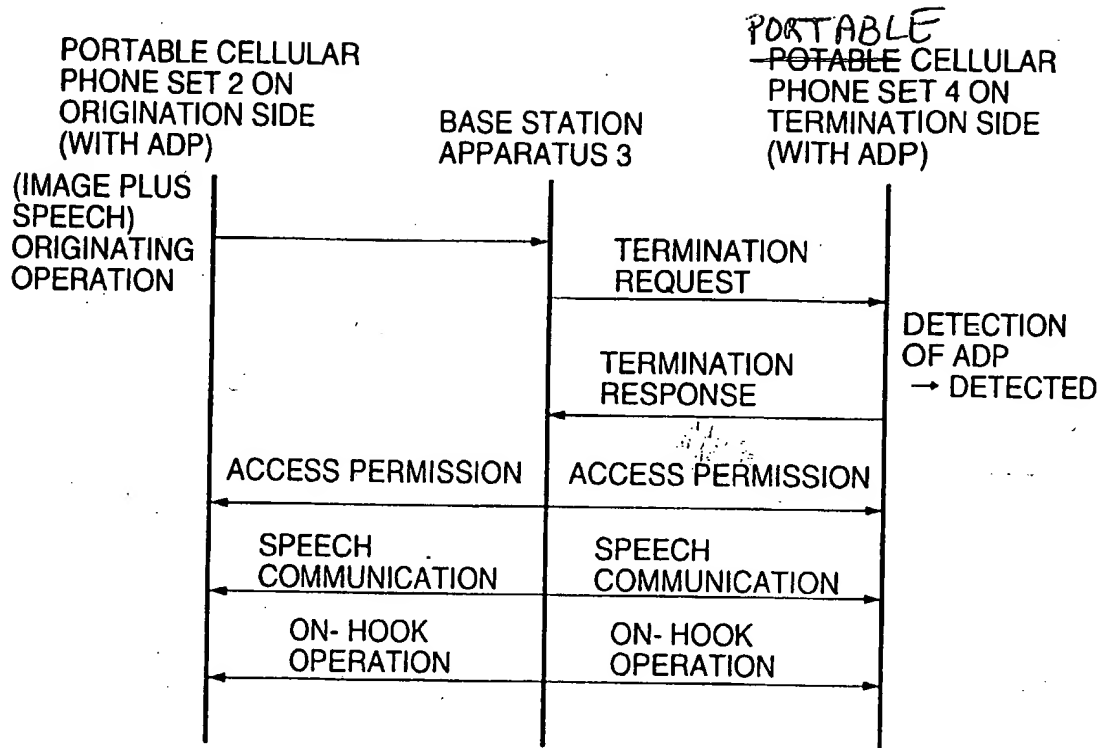


FIG.7B

